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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/055,998	01/28/2002	John K. Donovan	033455-002	3281

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EXAMINER

ELISCA, PIERRE E

ART UNIT	PAPER NUMBER
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3621

DATE MAILED: 05/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/055,998

Applicant(s)

DONOVAN, JOHN K.

Examiner

Pierre E. Elisca

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 December 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 5-28, 30 and 31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5-28, 30 and 31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☒ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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DETAILED ACTION

1. Regarding the status of the claims in the instant application, the Examiner has made an updated search and found new prior art. The Examiner is obliged to apply the newly found prior art. The Examiner regrets the delayed process of the application.

Accordingly, claims 1-3,5-28,30 and 31 are pending.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-3, 5-28, 30 and 31 are rejected under 35 U.S.C. 103 (a) as being unpatentable over Flood Gary (UK Home Office brings AI to immigration; computer weekly, n1233, p19 (1); 9/27/1990).

As per claims 1-3, 5-28, 30 and 31 Flood substantially discloses that a Britain's Home Office is using artificial intelligence (AI) to computerize its paper database of names of immigrants and temporary visitors. The Immigration and Nationality department of the Home Office is midway through a project to computerize its huge paper database of names of immigrants and temporary visitors to the UK, the method comprising the step of:

Storing information from Non-Immigrant Visa Holder authorized visa documentation in the database including information related to the timing of required reports by the Non-

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Immigrant Visa Holders, log onto a web site associated with the electronic system and database and transmit over the internet to the electronic system and database information requested by the website, and determining from said stored timing information and received reports, the identity of individuals who have failed to make timely reports (see., Flood, page 1). Flood does not explicitly detail that an entity officer or Non-Immigrant accessing the database remotely via a web site. However, the type of entities such as an entity officer or Non-Immigrant accessing the database remotely via a web site would not bring the claim into any patentable differences from David, as such it would have been obvious to one of ordinary skill in the art to recognize that an entity officer or Non-Immigrant is merely a user of the system, as such would not change the functioning or programming of David.

4. Claims 1-3, 5-28, 30 and 31 are rejected under 35 U.S.C. 103 (a) as being unpatentable over David Simcox, 3/1999, Ending Illegal Immigrant.

As per claims 1-3, 5-28, 30 and 31 David substantially discloses a method of finding overstayers in the U.S. The State department and INS must cooperate closely in developing a secure system for tracking nonimmigrant visitors from the receipt of their visa abroad. Individual case files should include personal data, the visa holder's declared personal, family, school or business contacts in the United States and travel arrangements, the method comprising the step of:

Storing information from Non-Immigrant Visa Holder authorized visa documentation in the database including information related to the timing of required reports by the Non-

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Immigrant Visa Holders, log onto a web site associated with the electronic system and database and transmit over the internet to the electronic system and database information requested by the website, and determining from said stored timing information and received reports, the identity of individuals who have failed to make timely reports (see., David, page 10). David does not explicitly detail that an entity officer or Non-Immigrant accessing the database remotely via a web site. However, the type of entities such as an entity officer or Non-Immigrant accessing the database remotely via a web site would not bring the claim into any patentable differences from David, as such it would have been obvious to one of ordinary skill in the art to recognize that an entity officer or Non-Immigrant is merely a user of the system, as such would not change the functioning or programming of David.

5. Claims 1-3, 5-28, 30 and 31 are rejected under 35 U.S.C. 103 (a) as being unpatentable over Immigration Statistics: Information Gaps, quality Issues Limit Utility of federal data to Policymakers, 9/7/1998.

As per claims 1-3, 5-28, 30 and 31 Immigration Statistics substantially discloses that INS is pilot-testing an automated entry-and-exit tracking system for all classes of non-immigrants at two airports and is continuing its attempts to solve the computer and other problems that have prevented reliable matches of entries and exits since 1992, the method comprising the step of:

Storing information from Non-Immigrant Visa Holder authorized visa documentation in the database including information related to the timing of required reports by the Non-

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Immigrant Visa Holders, log onto a web site associated with the electronic system and database and transmit over the internet to the electronic system and database information requested by the website, and determining from said stored timing information and received reports, the identity of individuals who have failed to make timely reports (see., Immigration Statistics, page 13). Immigration Statistics does not explicitly detail that an entity officer or Non-Immigrant accessing the database remotely via a web site. However, the type of entities such as an entity officer or Non-Immigrant accessing the database remotely via a web site would not bring the claim into any patentable differences from Immigration Statistics, as such it would have been obvious to one of ordinary skill in the art to recognize that an entity officer or Non-Immigrant is merely a user of the system, as such would not change the functioning or programming of Immigration Statistics.

Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pierre E. Elisca whose telephone number is 703 305-3987. The examiner can normally be reached on 6:30 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 703 305-9769. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Elisca Pierre Eddy

Primary Patent Examiner

April 27, 2005